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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/280,518	04/05/1999	KENSUKE FUJIWARA	32739M008	5926

7590

08/23/2002

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EXAMINER

PHAM, HAI CHI

ART UNIT

PAPER NUMBER

2861

DATE MAILED: 08/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 09/280,518	Applicant(s) FUJIWARA, KENSUKE	
	Examiner Hai C Pham	Art Unit 2861	

-- Th MAILING DATE of this communication appears on th cover sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: |

FINAL REJECTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

The original disclosure fails to provide support for the repeating steps of exposing a surface portion of the photoreceptor surface with laser light having an intensity corresponding to each of said second plurality of intensity values to provide exposed photoreceptor surface portions and detecting the potential of each of the exposed photoreceptor surface portions without repeating the step of dividing a predetermined laser intensity value to provide a second range of intensity values. Each pass through the loop in the process illustrated in Fig. 1 shows repeated performance of step S7, in which a region of laser intensities is further finely divided in each execution of the step as discussed at page 11, line 23 through page 12, line 17.

The second part of the invention involving the loop was summarized on page 13, lines 3-9 of the specification by emphasizing:

"When there is not obtained the desired preset potential, there are repeated operations of exposing photoreceptor 1 surface portions to laser lights of a plurality of further finely divided laser intensities and detecting the respective potentials, until there is obtained potential equal to or substantially equal to the predetermined set potential." (emphasis added)

which indisputably indicates that the step of dividing a predetermined laser intensity value to provide a second range of intensity values, is inclusive and is repeated within each loop until the predetermined set potential is satisfactorily obtained.

Response to Arguments

3. Applicant's arguments filed 06/18/02 have been fully considered but they are not persuasive.

Upon careful review of the original disclosure, the examiner maintains that the claimed repeating step, which repeats particular steps while omitting repetition of the dividing step, constitutes new matter, as the dividing step (Step S7) is necessarily repeated in the originally disclosed invention.

It is respectfully submitted that the original disclosure of "repeated operations of exposing photoreceptor 1 surface portions to laser lights of a plurality of further finely divided laser intensities, and detecting the respective potentials, until there is obtained potential equal to or substantially equal to the predetermined set potential" (emphasis added) on page 13, lines 4-9 of the specification, clearly indicates further laser intensity divisions for each repetition as opposed to Applicant's position that "the same intensity

values calculated in step S7 remain the same for each necessary repetition of the loop defined by steps S4-S7" (response, page 2, lines 2-4).

With regard to Applicant's argument on page 3, lines 7-10, namely "[T]hose of ordinary skill in the art would recognize that it would be of no further utility to further divide each of the fine intensity values, that is further divide the already small interval of $P_{MAX} \times (2/1023)$ ", the examiner respectfully submitted that such thinking was obviously not the Applicant's intention at the time that the present application was filed. There is no such suggestion found in the application. Moreover, in view of the fact that the specification clearly refers to "repeated operations of exposing photoreceptor surface portions to laser lights of a plurality of further finely divided laser intensities", with "further" clearly indicating that, in each repetition, the laser intensities are divided finely to a greater degree or extent, one of ordinary skill would interpret the specification as providing a narrowing of intervals in accordance with the further fine divisions. On the other hand, the logic of the flowchart as displayed in Fig. 1 of the present application indisputably calls for further the division of the laser intensities to be made at step S7 for each loop.

Applicant's declaration on page 3, lines 20-21, "[A]pplicant also points out that, in practice, repetition of the loop of steps S4-S7 usually is not necessary" further leads to a confusion in that such declaration would teach away from the essence of the current invention as it is originally disclosed.

For the above reason, claims 1-5 remain rejected under 35 U.S.C. 112, first paragraph, as stated above.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai C Pham whose telephone number is (703) 308-1281. The examiner can normally be reached on T-F (8:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John S. Hilten can be reached on (703) 308-0719. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, (703) 305-3432 for regular communications and for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in cursive script, appearing to read "Hai Pham".

HAI PHAM
PRIMARY EXAMINER

August 15, 2002